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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,673	06/27/2003	Chul Chung	G08.027/U	8308
28962 7590 07/08/2008 BUCKLEY, MASCHOFF & TALWALKAR LLC 50 LOCUST AVENUE NEW CANAAN, CT 06840				
EXAMINER				
GREENE, DANIEL LAWSON				
ART UNIT		PAPER NUMBER		
3694				
MAIL DATE		DELIVERY MODE		
07/08/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/608,673

**Applicant(s)**

CHUNG, CHUL

**Examiner**

DANIEL L. GREENE

**Art Unit**

3694

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 4-7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 8-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date 5/7/04, 10/02/03

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election without traverse of Invention I in the reply filed on 4/18/2008 is acknowledged.
2. Claims 4-7 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 4/18/2008.

### *Specification*

3. Applicant is reminded of the proper language, format and content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phrasology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

4. **The abstract of the disclosure is objected to because it is too short.** Correction is required. See MPEP § 608.01(b).

**5. The disclosure is objected to because of the following informalities:**

- a. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code (See for example, page 6 line 20). Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code.
- b. Page 6, line 22 contains the abbreviation EDGAR without first spelling out what it means or stands for.
- c. The use of the trademark Microsoft Access on page 8 line 8 has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology. Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.
- d. Page 10, line 19 contains the abbreviation CUSIP and ISIN without first spelling out what they mean or stand for.

e. Claim 1 is objected to because of the following informalities: A semicolon should be inserted after the word “to” in the limitation “a memory unit in communication with the processor and storing a program wherein the processor is operative with the program to”. Appropriate correction is required.

Appropriate correction is required. See MPEP § 608.01.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**6. Claims 1-3 and 8-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

Claims 1-3 and 8-16 recite a series of steps and are considered for the purpose of analysis under 35 U.S.C. 101 as merely reciting a series of steps. The claims do not recite a “pre” or “post” computer activity but merely perform a series of steps of receiving data and generate a data record associated with a transaction that does not explicitly require a computer.

A process is statutory if it requires physical acts to be performed outside of the computer independent of and following the steps performed by a programmed computer, where those acts involve the manipulation of tangible physical objects and result in the object having a different physical attribute or structure (*Diamond v. Diehr*, 450 U.S. at 187, 209 USPQ at 8).

Further, the claims merely manipulate an abstract idea (receiving data and generating a record) or perform a purely mathematical algorithm without limitation to any practical application.

A process which merely manipulates an abstract idea or performs a purely mathematical algorithm is non-statutory despite the fact that it might have some inherent usefulness (*Sakar*, 558 F.2d at 1335,200 USPQ at 139).

Furthermore, in determining whether the claimed subject matter is statutory under 35 U.S.C. 101, a practical application test should be conducted to determine whether a “useful, concrete and tangible result” is accomplished. See *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1359-60, 50 USPQ2d 1447, 1452-53 (Fed. Cir. 1999); *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1600 (Fed. Cir. 1998).

An invention, which is eligible for patenting under 35 U.S.C. 101, is in the “useful arts” when it is a machine, manufacture, process or composition of matter, which produces a concrete, tangible, and useful result. The fundamental test for patent eligibility is thus to determine whether the claimed invention produces a “useful, concrete and tangible result”. The test for practical application as applied by the examiner involves the determination of the following factors”

- (a) “Useful” - The Supreme Court in *Diamond v. Diehr* requires that the examiner look at the claimed invention as a whole and compare any asserted utility with the

claimed invention to determine whether the asserted utility is accomplished.

Applying utility case law the examiner will note that:

- i. the utility need not be expressly recited in the claims, rather it may be inferred.
- ii. if the utility is not asserted in the written description, then it must be well established.

(b) "Tangible" - Applying *In re Warmerdam*, 33 F.3d 1354, 31 USPQ2d 1754 (Fed. Cir. 1994), the examiner will determine whether there is simply a mathematical construct claimed, such as a disembodied data structure and method of making it. If so, the claim involves no more than a manipulation of an abstract idea and therefore, is nonstatutory under 35 U.S.C. 101. In *Warmerdam* the abstract idea of a data structure became capable of producing a useful result when it was fixed in a tangible medium, which enabled its functionality to be realized.

(c) "Concrete" - Another consideration is whether the invention produces a "concrete" result. Usually, this question arises when a result cannot be assured.

The claims, as currently recited, appear to be directed to nothing more than a series of steps including gathering data and generating data without any useful, concrete and tangible result and are therefore are deemed to be non-statutory.

The claims must be drafted to ensure the use of a computer is undeniable in the process of the invention. To allow for the method to be performed without requiring a computer to do so, falls outside of the prerequisites of 35 U.S.C. 101.

Further, claim 11 does not require a computer and can be performed by hand.

Although the claims are interpreted in light of the specification, limitations from the specification are NOT imported into the claims. The Examiner must give the claim language the broadest reasonable interpretation the claims allow.

See MPEP 2111.01, which states

While the claims of issued patents are interpreted in light of the specification, prosecution history, prior art and other claims, this is not the mode of claim interpretation to be applied during examination. During examination, the claims must be interpreted as broadly as their terms reasonably allow. In re American Academy of Science Tech Center, F.3d, 2004 WL 1067528 (Fed. Cir. May 13, 2004)

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

**8. Claims 1-3 and 8-16 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by U.S. Patent 6,317,727 B1 to May.**

**Regarding claims 1, 8 and 11**, May clearly discloses a method, a medium storing said method and a system to support a derivative transaction, comprising:

a processor (50, 82, 112, etc);

a communications device (52, 84, 124, etc.), in communication with said processor, receiving data; and

a memory unit (64, 98, etc) in communication with the processor and storing a program, wherein the processor is operative with the program to



receive data identifying a reference entity participating in said derivative transaction;

receive data identifying at least a first reference obligation associated with said derivative transaction;

identify a contractual relationship between said reference entity and said at least first reference obligation; and

generate a data record associated with said derivative transaction, said data record including said data identifying said reference entity, said data identifying said at least first reference obligation, and data identifying said contractual relationship, wherein said data record is verified as accurate as of an issue date of said derivative transaction in, for example, The Abstract, Figures, Col. 1 lines 35-50, Col. 5 lines 31-38, etc.

**Regarding claims 2, 3, 12 and 13**, May performs the credit analysis on a real time basis which is as periodic as one can get. Further, May updates the system as things change to reflect the changes in credit. See for example, Col. 6 lines 42-51, etc.

**Regarding claims 9 and 10**, See for example, figures, 10, 14A, etc and their associated text to show that May clearly discloses a step to enforce conventions to provide consistent data entry by providing a form to fill out.

**Claim 14** is inherently disclosed because a name change would clearly be alter the account of a trader and be reflected real time as this one of the purposes of the invention, i.e. update info in real time.

**Claims 15 and 16** are also inherently disclosed by May as an increase or decrease in the amount of credit directly affects an individual's credit score. See also for

examples, Col. 1 line 50 through col. 2 line 40, etc. wherein additional liabilities (debt) and release from obligations are set forth.

### *Conclusion*

9. Examiner's Note: The Examiner has cited particular columns and line numbers in the references as applied to the claims for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL L. GREENE whose telephone number is (571)272-6876. The examiner can normally be reached on Mon-Thur.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3694

11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. L. G./  
Examiner, Art Unit 3694  
2008-07-06

/James P Trammell/  
Supervisory Patent Examiner, Art Unit 3694